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| 09/993,429 | 11/13/2001 | Nisheeth Ranjan | AOL0019 | 7537 |

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

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| EXAMINER |
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SHAPIRO, LEONID

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| ART UNIT | PAPER NUMBER |
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2677

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/993,429 | Applicant(s) RANJAN, NISHEETH | |
| | Examiner Leonid Shapiro | Art Unit 2677 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-23 and 25-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-23 and 25-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the newly introduced limitation of independent claims 1 and 21 : "step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider" and newly introduced claims 33-34: "capturing digitally any of motion of pen; video of an area half an inch above tip of pen or pen, page number on first media " must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the newly introduced limitation of independent claims 1 and 21: "step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider" and newly introduced claims 33-34: "capturing digitally any of motion of pen; video of an area half an inch above tip of pen or pen, page number on first media " are not described in the Disclosure.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 22-23, 25-28, 33-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly introduced limitation of independent claims 1 and 21: "step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider" and newly introduced claims 33-34: "capturing digitally any of motion of pen; video of an

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area half an inch above tip of pen or pen, page number on first media " are not described in the Disclosure or shown in the Figures.

Claim 2 is dependent on claim 1.

Claims 22-23, 25-28 are dependent on claim 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-10, 14, 16-23 and 25-30, 40,42 are rejected under 35 U.S.C.

102(e) as being anticipated by Lapstun et al. (200310169864).

With regard to claim 1 Lapstun et al. teaches a method for wireless transmission of information from a first media to a second media (figure 8), comprising the steps of: entering said information on said first media (figure 8, item 504), wherein said first media comprises paper media (figure 2, item 1 section 0049), wherein said information is entered via a Bluetooth-enabled pen (section 223); and transferring said information from said first media to said second media (figure 2, items 101 and 10), wherein said step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider (figure 87, items A, 503, section 0100 and section 0154), wherein said second media

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comprises online electronic media (figure 2, item 10, section (0052)). Lapstun also teach that the second media is an online duplicate of the first media (section [0092], where Lapstun shows that the ink is sensed by an optically imaging pen, and transmitted to the net page). This simply means that when the pen moves on the encoded paper, it reads the data and then transmitted to the second media via the netpage system, which means that the data sensed by the pen is duplicated.

With regard to claims 2, 40 Lapstun et al. teaches said Bluetooth-enabled pen (marking device) (section (0223)) further comprises: a receiver device and a transmitter device (section (0157)).

With regard to claim 3 Lapstun et al. teaches a method for wireless transmission of information from a first media to a second media (figure 8), comprising the steps of: entering said information on said first media (figure 8, item 504); and transferring said information from said first media to said second media via an ad-hoc network (figure 8, items 101, 503, A, section (0154). Lapstun also teach that the second media is an online duplicate of the first media (section [0092], where Lapstun shows that the ink is sensed by an optically imaging pen, and transmitted to the net page). This simply means that when the pen moves on the encoded paper, it reads the data and then transmitted to the second media via the netpage system, which means that the data sensed by the pen is duplicated.

With regard to claim 4 Lapstun et al. teaches that the first media comprises paper media and the second media comprises electronic media (section [0049] and section [0052]).

With regard to claim 6 Lapstun et al. teaches that the first media comprises a paper book (section [0096]).

With regard to claim 7 Lapstun et al. teaches that the first media comprises a paper magazine (section [0096]).

With regard to claim 8 Lapstun et al. that the first media comprises a paper shopping catalog (section [0096]).

With regard to claim 9 Lapstun et al. teaches that the ad-hoc network is Bluetooth network (figure 8, items 101, 503, A, section [0154]).

With regard to claim 10 Lapstun et al. teaches that transferring the information comprises overlaying the information on the second media (figure 22 illustrates where you write a short message on paper whereby that information is overlay in the network and sent to a receiver).

With regard to claim 14 Lapstun et al. teaches that the entering the information compises writing a note on a portion of the first media (figure 22 whereby it is inherent that a user is capable of using his pen this way when writing a message).

With regard to claim 16 Lapstun et al. teaches the step of providing a dictionary meaning for the selected word on the second media (figure 22 whereby it is inherent that a user is capable of writing the dictionary meaning of any word he writes down).

With regard to claim 17 Lapstun et al. teaches the method of claim 10, wherein the entering the information comprises filling up a form (figures 18 and 22).

With regard to claim 18 Lapstun et al. teaches that the form comprises a tax form [section (0096)].

With regard to claim 19 Lapstun et al. teaches that the form comprises a purchase order (section (0096])

With regard to claim 20 Lapstun et al. teaches the method of claim 4, wherein the electronic media comprises Internet-based media (section [0101).

With regard to claims 21 Lapstun et al. teaches an apparatus for online transmission of information from a first media to a second media (figure 8), comprising: a marking device configured to enter said information on said first media (figure 8, item 101); and a transmitter configured to transmit said information entered on said first media to said second media, the transmitter being connected to said marking device (figure 2, item -9), said transmitter transmitting directly to a computer connected to a Web server (fig. 8, items 101, 503,A, section 0154). Lapstun also teach that the second media is an online duplicate of the first media (section [0092], where Lapstun shows that the ink is sensed by an optically imaging pen, and transmitted to the net page). This simply means that when the pen moves on the encoded paper, it reads the data and then transmitted to the second media via the netpage system, which means that the data sensed by the pen is duplicated.

With regard to claims 22-23 and 25-28 Lapstun et al. was shown above in claims 1-4 and 6-20 to cover all these limitations.

As to claim 29, Lapstun et al. teaches step of transferring does not transfer said information via a netpage printer to a phone (fig. 8, items 101, 503,A, section 0154).

As to claim 30, Lapstun et al. teaches pen with a tip (fig. 2, item 101) and a transmitter device (section (0157]).

As to claim 42, Lapstun et al. teaches *ad-hoc* connection to a Web server (fig. 8, items 101, 503, A, section 0154).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-13, 15, 38, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. in view of Montlick (US Patent No. 5,561,446).

As to claims 11-13, 15, Lapstun et al. does not disclose circling, underlining, highlighting and selecting a word on a portion of first media.

Montlick teaches circling an area on the illustration (See Figs. 5-7, item , 12b, 62a-62b, Col. 9, Lines 25-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Montlick teachings into Lapstun et al. system in order to collect handwritten information including , underlining, highlighting and selecting a word in real time from a pen-based computer using a wireless network (See Col. 2, Lines 42-45 in the Montlick reference).

As to claim 38, Montlick teaches first media does not consist of a netpage form (See Fig. 5, item 12c).

As to claim 41, Montlick teaches a digital image capture device (fig. 2, item 101) and a transmitter device (fig. 3, Col. 8, lines 10-64).

8. Claims 31-32, 35-37, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. in view of Want et al. (US Patent No. 6,008,727).

As to claims 31-32, Lapstun et al. does not disclose a radio-frequency tag with pen close to first media.

Want et al. teaches a radio-frequency tag with pen close to first media (See Fig. 1, items 32, 14, Col. 7, Lines 38-56 and from Col. 8, Line 66 to Col. 9, Line 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Want et al. teachings into Lapstun et al. system in order to identify different device (See Col. 1, Lines 62-67 in the Want et al. reference).

As to claims 35-37, Lapstun et al. teaches pen is Bluetooth enabled and step of transferring couples said Bluetooth-enabled pen to an online service provider via a computer (section 0223).

As to claim 39, Want et al. teaches a radio-frequency tag(See Fig. 1, items 32, 14, Col. 7, Lines 38-56 and from Col. 8, Line 66 to Col. 9, Line 6).

Response to Arguments

6. Applicant's arguments filed 09/20/05 have been fully considered but they are not persuasive:

On page 11, first paragraph of Remarks, Applicant's stated that the netpage printer is performing communication with a page server. However, Lapstun et al. teaches in section 0141: "... although specific reference is made to a netpage printer, any netpage base station can be used, i.e. any device which receives input from a netpage sensing device and either interprets the input directly or forwards the input to one more network servers for interpretation". Also See Figure 8, items A, 503, section 0154.

On the same page, first paragraph of Remarks, Applicant's also stated that support for the newly introduced limitation of claim could be found. However, nowhere in Figures or in Specification one could find: "... couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider". For example, on page 6, Line 8, Applicant's stated: "... a computer system, a network of computer systems ...". As well understood in the art, a computer system could also comprise multiple devices.

On page 12, last paragraph of Remarks, in relation to independent claim 3, Applicant's stated that netpage printer communicates indirectly via a netpage printer with a netpage server. However, Lapstun et al. teaches in section 0141: "... although specific reference is made to a netpage printer, **any netpage base station can be used**, i.e. any device which receives input from a netpage sensing device and either interprets the input directly or forwards the input to one more network servers for interpretation", which is *ad hoc* point-to-point wireless solution.

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On page 13, 1st paragraph of Remarks, in relation to claim 9, Applicant's stated that netpage printer communicates indirectly via a netpage printer with a netpage server. However, Lapstun et al. teaches in section 0141: "... although specific reference is made to a netpage printer, **any netpage base station can be used**, i.e. any device which receives input from a netpage sensing device and either interprets the input directly or forwards the input to one more network servers for interpretation", which is *ad hoc* point-to-point wireless solution.

Telephone Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 571-272-7683. The examiner can normally be reached on 8 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on 571-272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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AMR A. AWAD
PRIMARY EXAMINER

